

REMARKS

Claims 1-21 are currently pending in the subject application, and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1, 2, 4, 5, 10, 11, 13, 14, 19, and 20 Under 35 U.S.C. §102(b)

Claims 1, 2, 4, 5, 10, 11, 13, 14, 19, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Lin (U.S. Pat. 4,999,755).

Applicable Law

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *Id.* (quoting *Continental Can co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). "In addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Lin does not anticipate claim 1 and claims 2, 4, 5, and 10, which depend therefrom. Claim 1 recites an indicator apparatus which includes at least one elongated strip of substantially translucent material extending through the first side and at least one of the second and third sides of a housing so that part of the strip is visible at the first side and the at least one of the second and third sides. Lin discloses a continuous length of plastic, translucent tubing for supporting a plurality of sockets, which in turn, support light units. Lin does not expressly or inherently disclose an elongated strip of substantially translucent material, which, as recited in claim 1, extends through a first side and at least one of second and third sides of the housing. Rather, Lin describes cube-shaped sockets configured to

fit inside the hollow square cross-section of the tube. A bulb extends from the socket. Because the elongated strip recited in claim 1 is absent from Lin, Lin does not anticipate claim 1 and its dependent claims.

Furthermore, Lin does not anticipate claim 11 and claims 13, 14, and 19, which depend therefrom. Claim 11 recites a substantially translucent material being disposed in a slot adjacent a light source that is operative to, when activated, illuminate the translucent material. Lin describes sockets, molded from insulating material, being disposed within a continuous hollow tube. The sockets, as shown in Figs. 1-16, appear to be of a substantially opaque material from which a light bulb may protrude. Moreover, the continuous hollow tube does not include a slot, as recited in claim 11. For example, the light bulbs, as shown and described in Lin, are supported by the sockets and are not operative to illuminate a substantially translucent material disposed within a slot. Therefore, Lin does not anticipate claim 11.

Claim 20 recites a substantially translucent means extending through the sidewall portion of the housing means for transmitting emitted light from the illumination means so as to be visible from a plurality of sides of the outer sidewall portion of the housing. As discussed above, Lin teaches a continuous hollow tube with sockets disposed within the tube from which light bulbs may extend. Lin does not expressly or inherently disclose a substantially translucent means extending through the sidewall portion of the housing.

For these reasons, withdrawal of this rejection and allowance of independent claims 1, 11, and 20 and their dependent claims 2, 4, 5, 10, 13, 14, and 19 are respectfully requested.

II. Rejection of Claims 3, 6-9, 12, and 15-18 Under 35 U.S.C. §103(a)

Claims 3, 6-9, 12, and 15-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lin in view of Duerkob (U.S. 4,954,808). Claims 3 and 6-9 depend directly and indirectly from independent claim 1. Duerkob does not make up for the aforementioned deficiencies of Lin with respect to claim 1. Therefore, claims 3 and 6-9 are not obvious over the combination of Lin and Duerkob.

Claims 12 and 15-18 depend directly and indirectly from independent claim 11. Duerkob does not make up for the aforementioned deficiencies of Lin with respect to claim 11. Therefore, claims 12 and 15-18 are not obvious over the combination of Lin and Duerkob.

Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claim 21 Under 35 U.S.C. §103(a)

Claim 21 stands rejected under 35 U.S.C. as being unpatentable over Lin in view of Schneider *et al.* (U.S. Pat. Des. 391,182).

Claim 21 recites at least one elongated strip of substantially translucent material extending through at least one side of the sidewall portion through to another side of the sidewall portion so that part of the strip is visible at the at least one side and the another side of the sidewall portion. For the aforementioned reasons, it is respectfully submitted that Lin does not individually teach or suggest this claim limitation to a person possessing ordinary skill in the art.

Schneider *et al.* does not make up for the aforementioned deficiencies of Lin. Schneider *et al.* discloses an ornamental design for an indicator for a proximity sensor. Schneider *et al.* does not show or suggest an elongated strip of substantially translucent material extending through at least one side of the sidewall portion to another side of the sidewall portion of the indicator housing. Therefore, Schneider *et al.* does not individually suggest the claimed subject matter to a person possessing ordinary skill in the art. Furthermore, the combination of Lin and Schneider *et al.* does not suggest the system recited in claim 21 to a person possessing ordinary skill in the art because the recited combination of structural and functional features is absent from such references. Accordingly, withdrawal of this rejection is respectfully requested and allowance of claim 21 is earnestly solicited.

IV. Conclusion

The present application is believed to be condition for allowance in view of the above amendments and comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 01-0857.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Allen-Bradley Company, Inc.



Alexander M. Gerasimow
Alexander M. Gerasimow
Reg. No. 28,610

Rockwell Automation
Attention: Alexander M. Gerasimow
Patent Dept 704P
1201 South Second Street
Milwaukee, Wisconsin 53204

(414) 382-5885 (telephone)
(414) 382-3900 (facsimile)

RECEIVED

MAY 2 2001

Technology Center 2600